IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.:   09/653,227 §

Filed: August 31, 2000 §

Inventor: §

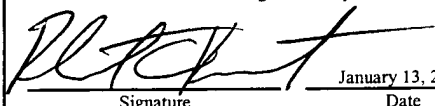   Traversat, et al. §

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Title: Message Authentication §

      Using Message Gates in §

      a Distributed Computer §

      Environment §

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§

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Examiner: Chen, Shin Hon

Group/Art Unit: 2131

Atty. Dkt. No: 5181-64800

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Robert C. Kowert
_____
Name of Registered Representative

_____   January 13, 2006
Signature   Date

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated below.

Claims 1-6, 8-31, 33-47 and 49-72 remain pending in the application. Reconsideration of the present case is earnestly requested in light of the following remarks. Please note that for brevity, only the primary arguments directed to the independent claims are presented, and that additional arguments, e.g., directed to the subject matter of the dependent claims, will be presented if and when the case proceeds to Appeal.

The Examiner rejects claims 1-6, 8-31, 33-47 and 49-72 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-47 of co-pending Application No. 09/653,215. Applicants traverse this rejection on the grounds that the Examiner has not stated a proper *prima facie* rejection.

The only support given by the Examiner for the rejection is that "both applications are claiming [a] method for accessing a service in a distributed computing environment in which a client request[s] capability credentials to access [a] portion of a service through advertisement." However, simply because both applications claim some overlap in subject matter is not a proper reason for holding the claims of the present application obvious from the claims of the listed applications. According to MPEP 804.II.B.1, "the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection." This

section of the MPEP also states that the same "factual inquires ... that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are employed when making an obviousness-type double patenting analysis." MPEP 804.II.B.1 also states that the Examiner should list the differences between **each** rejected claim and the claims of the other patent/application, and for **each** difference the Examiner should give the reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim is an obvious variation of the invention defined in a claim of the other patent/application. Simply stating that the claims both recite some overlap in subject matter is not a valid reason why a person of ordinary skill in the art would conclude that the invention defined in each claim is an obvious variation of the invention defined in a claim of the other patent/application. Nor has the Examiner specifically addressed **each difference** of **each claim** of the present application compared to the claims of the other applications. Instead, the Examiner improperly lumped all the claims together and did not address each specific difference. The Examiner clearly has not met the requirements stated in MPEP 804.II.B.1 to establish a *prima facie* obviousness-type double patenting rejection. Accordingly, Applicants respectfully request removal of the double patenting rejection of claims 1-6, 8-31, 33-47, and 49-72.

The Examiner rejected claims 1, 2, 8-13, 15-17, 20, 21 and 23-26 under 35 U.S.C. § 102(a) as being anticipated by Adams (U.S. Patent 6,718,470). The Examiner also rejected claims 3-6, 18 and 19 under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Czerwinski, et al. ("An Architecture for a Secure Service Discovery Service") (hereinafter "Czerwinski"), and claims 27-31, 33-36, 38-45, 47, 49-53, 55-59, 61-67, 60, 70 and 72 under 35 U.S.C. § 102(a) as being anticipated by Adams or under 35 U.S.C. § 103(a) as being unpatentable over Adams in view of Czerwinski. Applicants respectfully traverse these rejections for at least the reasons below.

Regarding claim 1, contrary to the Examiner's assertion, Adams fails to disclose determining client capabilities for a client, where the client capabilities are capabilities of the first service that the client is permitted to use. Adams teaches a system for granting security privileges by providing test criteria data so that matching security privilege certificates (or other authorization credentials) may be selected from among multiple subscriber privilege data. Adams teaches that certificates, such as Kerberos tickets, privilege attribute certificates, or other public key certificates (Adams, column 7, lines 48-55) may be selected from among multiple privilege data based on test criteria supplied by a relying unit (such as a software application, computer node or other entity). A selector entity may search a common repository of security privilege certificates. The selector entity then returns any and all privilege data that meets the test criteria data. Thus, the selector unit may return multiple certificates, each of each meets the test criteria data. (see, Adams, column 3, lines 26-59; column 4, lines 25-36; and column 5, lines 18-46). However, Adams fails to mention anything about determining the client's capabilities, where the client capabilities are capabilities of the first service that the client is permitted to use.

The Examiner cites column 6, lines 49-61 and specifically refers to Adams' centralized privilege data selector. However, the cited passage does not describe determining a client's capabilities. Instead, the cited passage only refers to how Adams' privilege data selector selects among privilege data for a plurality of subscribers. As noted above, Adams teaches that his data selector selects privilege data that meets test criteria data supplied by the relevant relying party. Thus, the privilege data selector does not determine a client's capabilities, but instead only compares the potential privilege data, such as may be stored in a certificate repository, to the supplied test criteria data. Adams does not describe his privilege data selector as determining client capabilities. Instead, Adams teaches that the privilege data selector selects among subscriber privilege data "based on the privilege test criteria data." Nowhere does Adams

mention determining a client's capabilities where the client capabilities are capabilities of the first service that the client is permitted to use.

Adams also fails to disclose <u>binding the client capabilities to the authentication credential</u>. The Examiner cites column 6, lines 65-66 and argues that the matching attributes are sent as pre-qualification data. However, the matching attributes referred to in the cited passage are the authentication credentials (such as Kerberos tickets, privilege attribute certificates or other public key certificates) and are not bound to any client capabilities. Nowhere does Adams mention binding determined client capabilities to an authentication credential. The cited passage only states that any attribute certificates matching the test criteria data are sent as pre-qualification privilege data back to the subscriber unit. Adams also teaches that after the subscriber unit sends the pre-qualification privilege data to the relying unit, the relying unit performs a pre-qualification privilege verification to ensure that the supplied attribute certificates do indeed meet the test criteria data. Sending matching attribute certificates and verifying that they match certain test criteria data does not have anything to do with binding client capabilities to an authentication credential.

Additionally, Adams fails to disclose the service <u>using the authentication service</u> to <u>authenticate the authentication credential</u> received in the message from the client. The Examiner cites column 7, lines 3-8 where Adams teaches that after the subscriber unit sends pre-qualification privilege data to the relying unit, the relying unit performs a pre-qualification privilege verification to ensure that the supplied attribute certificates do indeed meet the test criteria data. The Examiner also argues, "the relying party uses the centralized privilege data selector to generate credential for authentication." However, generating an authentication credential is not the same as using an authentication service to authenticate an authentication credential obtained from the authentication service by a client and sent to the service, as recited in claim 1. Furthermore, the cited passage does not support the Examiner's statement. Instead, the cited passage states that the relying party unit performs the pre-qualification privilege verification and sends a confirmation message back to the subscriber unit. However, the pre-qualification privilege verification does not involve the relying unit using the central privilege data selector to perform the verification. Adams teaches that the pre-qualification privilege verification involves comparing the test criteria data with the pre-qualification privilege data (e.g. the attribute certificates) "to see if they are consistent." Adams system involves the relying unit verifying that the attribute certificates actually meet the test criteria data. Contrary to the Examiner's assertion, nowhere does Adams state that the privilege data selector is used as part of this verification.

Applicants remind the Examiner that anticipation requires the presence in a single prior art reference disclosure of <u>each and every limitation</u> of the claimed invention, <u>arranged as in the claim</u>. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The <u>identical</u> invention must be shown <u>in as complete detail</u> as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As discussed above, Adams fails to disclose <u>determining client capabilities for a client</u>, where the client capabilities are capabilities of the first service that the client is permitted to use, <u>binding the client capabilities to the authentication credential</u>, and the service <u>using the authentication service</u> to <u>authenticate the authentication credential</u> received in the message from the client. Therefore, Adams clearly cannot be said to anticipate claim 1.

For at least the reasons above, the rejection of claim 1 is not supported by the prior art and removal thereof is respectfully requested. Similar remarks also apply to claims 27, 43, 51 and 62.

Regarding claim 17, Adams fails to disclose a client <u>obtaining a service advertisement</u> for a service, where the service advertisement <u>includes an address for an authentication service</u>. The Examiner cites column 31-67. However, the cited passage makes no mention of a client obtaining a service advertisement for a service that includes an address for an authentication service. Instead, the cited passage describes one embodiment of Adams' system in which the relying party sends privilege test criteria data to a centralized privilege data selector and in which a subscriber sends identification information to the centralized privilege data selector. The data selector then returns to the subscriber all attribute certificates from a certificate repository that meet the received test criteria data. The subscriber then transmits the returned certificates to the relying unit. No mention is made in the cited passage regarding a client obtaining a service advertisement for a service, where the service advertisement includes an address for an authentication service. According to the Examiner's interpretation, Adams' subscriber would have to obtain a service advertisement for the relying party unit and the service advertisement would have to include an address for the centralized privilege data selector. However, Adams system does not include any service advertisement for a relying party unit that includes an address for the centralized privilege data selector. The Examiner has clearly misinterpreted the teachings of Adams.

Additionally, Adams does not disclose the client <u>generating a message gate</u> for accessing the service, where the message gate <u>embeds the authentication credential in *every* message</u> from the client to the service. The Examiner cites column 6, lines 65-67 where Adams states that any matching attribute certificates are sent as pre-qualification privilege data back to the subscriber unit and that the subscriber unit then transmits the pre-qualification privilege data to the relying unit through a suitable communication link. The cited passage does not mention anything about the subscriber unit, which the Examiner considered a client, generating a message gate that embeds the authentication credential in every message from the client to the service. The mere mention of "a suitable communication link" does not disclose the specific limitation of generating a message gate that embeds an authentication credential in every message. Adams does not describe, either at the cited passage or elsewhere, anything about message gates or embedding an authentication credential in every message from a client to a service. The Examiner is merely relying upon speculation, which is clearly improper.

Thus, for at least the reasons above, the rejection of claim 17 is not supported by the cited art and removal thereof is respectfully requested. Similar remarks also apply to claims 58 and 69.

Regarding the § 102(a) of independent claims 27, 43, 51 and 62, please refer to the remarks above regarding the § 102 rejection of claim 1, as they apply with equal force to claims 27, 43, 51 and 62. Similarly, regarding the § 102(a) of independent claims 58 and 69, please refer to the remarks above regarding the § 102 rejection of claim 17, as they apply with equal force to claims 58 and 69.

Regarding the alternative § 103(a) rejection of independent claims 27, 43, 51, 58, 62 and 69 the Examiner has failed to provide a proper rejection. For each of these independent claims (as well as for several of their respective dependent claims) the Examiner rejects them merely "for the same reasons set forth in rejecting" either claim 1 or claim 17. However, claims 1 are 17 are not rejected under § 103(a) over Adams in view of Czerwinski. It has been very well established that to establish a prima facie case of obviousness (e.g. a proper § 103(a) rejection) three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations. (See, M.P.E.P. § 2143). The Examiner has not met any of the three basic requirements of a proper §

103(a) rejection of claims 17 and 33. Furthermore, the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." If the Examiner does not produce a *prima facie* case, "the applicant is under no obligation to submit evidence of nonobviousness." (see, M.P.E.P. § 2142).

The Examiner has not provided any argument or explanation regarding the proposed combination of Adams and Czerwinski in regard to independent claims 27, 43, 51, 58, 62 and 69. Nor has the Examiner shown how a combination of Adams and Czerwinski might teach or suggest all the limitations in each of the rejected claims. Nor has the Examiner provided any motivation to combine the teachings of Adams and Czerwinski in the rejection of claims 27, 43, 51, 58, 62 and 69. Thus, the Examiner has failed to provide a proper *prima facie* § 103(a) rejection of claims 27, 43, 51, 58, 62 and 69. Applicants also note that deficiencies of Czerwinski in regard to claims 27, 43, 51, 58, 62 and 69 are discussed in Applicants' previously filed Appeal Brief from which the Examiner reopened prosecution with the current rejection. For the reasons stated above in regard to Adams and the reasons stated in the previous Appeal Brief in regard to Czerwinski, it is clear that neither Adams nor Czerwinski, alone or in combination, teaches or suggests all the limitations of independent claims 27, 43, 51, 58, 62 and 69.
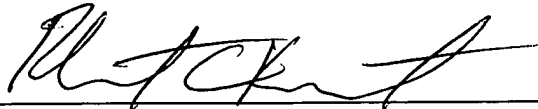
Thus, for at least the reasons given above, the rejections of independent claims 27, 43, 51, 58, 62 and 69 are not supported by the prior art and removal thereof is respectfully requested.

In light of the foregoing remarks, Applicant submits the application is in condition for allowance, and notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5181-64800/RCK.

Also enclosed herewith are the following items:

☒ Return Receipt Postcard
☒ Notice of Appeal

Respectfully submitted,

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Date: ___August 26, 2005___